REMARKS

Claim 14 is the sole independent claim and stands rejected under 35 U.S.C. § 102 as being anticipated by JP '576 and JP '730, and is further rejected under the judicially created doctrine of obviousness-type double patenting over USP No. 6,598,421. With respect to the double-patenting, in order to expedite prosecution, a terminal disclaimer is enclosed herein to obviate this rejection.

Turning to the prior art rejections, the preamble of each of the pending claims has been amended to recite " ... method for producing a rotator of a compressor which uses a nonpolar refrigerant as a working fluid ... ." As noted in MPEP § 2116.01, "all the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a ***process or method claim.***" One aspect of the present invention is directed to having a low-dielectric constant plastic film as part of an insulation layer for a compressor *in combination* with *use* of a non-polar refrigerant (*see, e.g.*, page 9, line 23 – page 10, line 19 of Applicants' specification). None of the cited prior art appears to suggest such a combination.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that the cited prior art does not anticipate claim 14, nor any claim dependent thereon.

The Examiner is further directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for a § 103 rejection:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejections do not "establish *prima facie* obviousness of [the] claimed invention" as recited in the pending claims because the cited prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 14 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on all the foregoing, it is submitted that claims 14-21 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's

amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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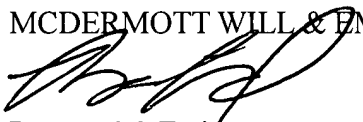

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